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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,483	03/12/2004	Toshiyuki Nagaoka	12577/33	6696
23838	7590	08/21/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
			EXAMINER NGUYEN, LUONG TRUNG	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,483	Applicant(s) NAGAOKA, TOSHIYUKI	
	Examiner LUONG T. NGUYEN	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,8,11,12,16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 3,5,7,9,10,13-15,17 and 19-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species X (Figure 10) in the reply filed on 06/04/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 3, 5, 7, 9, 10, 13, 14, 19-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/04/2007.

In addition, claims 15, 17 are with drawn from the consideration for the following reason.

Claim 15 recites limitation "wherein the transmittance variable element comprises an electrochromic element." The sixth embodiment (figure 6), Specification (page 20) supports for this limitation. Figure 6 is a non-elected species. Figure 10 does not disclose this limitation. Therefore, claim 15 is with drawn from the consideration by the examiner.

Claim 17 recites limitations "a sensor part, an operation processing part, a control part." Figure 11 discloses sensor part 113, operation processing part 114, control part 115. Figure 11 is a non-elected species. Figure 10 does not disclose this limitation. Therefore, claim 17 is with drawn from the consideration by the examiner.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

4. Claim 4, 8 are objected to because of the following informalities:

Claim 4 (line 2), "wherein plural optical systems" should be changed to --wherein the plural optical systems--.

Claim 4 (lines 2-3), "the one imaging element" should be changed to --the imaging element--.

Claim 8 (line 2), "the transmittance variable elements" should be changed to -- the transmittance variable element--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 16 recites limitation "a

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control part” which corresponds to control part 106 in figure 10. However, there is no support for the limitation “a transmittance control device,” which is recited in claim 16.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (line 7), claim 2 (line 7) both recite the limitation “the” in “the focal length”.

Claim 8 (line 2), recites the limitation “the” in “the lens”.

There is insufficient antecedent basis for this limitation in the claim.

Claims 4, 6, 8, 11, 12, 16, 18 are rejected as being dependent on claim 1.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 6, 8, 11, 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoneham (US 4,801,958).

Regarding claim 1, Stoneham discloses an imaging apparatus comprising;

an imaging element (exposure plane 11', figure 2, column 2, lines 43-67),

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plural optical systems having different focal lengths (lens 1' and lens 3', figure 2, column 2, lines 43-67),

a transmittance variable element (combination of mirror 7' and aperture plane defining plate 17', figure 2, column 2, line 43 – column 3, line 36),

a reflective optical element (mirrors 5', 7', figure 2, column 2, lines 43-67),

wherein the focal length is changed by controlling transmittance of the transmittance variable element (the mirror 7' is movable for selecting longer focal length lens 1' or shorter focal length 3', figure 2, column 2, line 43 – column 3, line 36).

Regarding claim 2, Stoneham discloses an imaging apparatus comprising;

an imaging element (exposure plane 11', figure 2, column 2, lines 43-67),

plural optical systems having different focal lengths (lens 1' and lens 3', figure 2, column 2, lines 43-67),

a transmittance variable element arranged at the object side rather than the plural optical systems (combination of mirror 7' and aperture plane defining plate 17', which is located at the object side, figure 2, column 2, line 43 – column 3, line 36),

wherein the focal length is changed by controlling transmittance of the transmittance variable element (the mirror 7' is movable for selecting longer focal length lens 1' or shorter focal length 3', figure 2, column 2, line 43 – column 3, line 36).

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Regarding claim 4, Stoneham discloses wherein the plural optical systems are corresponding to the one imaging element (lens 1' and lens 3' are corresponding to the exposure plane 11', figure 2), and a center of an imaging area is substantially conformed with the optical axes of the plural optical systems (the center of the exposure plane 11' is conformed with the optical axis Z', figure 2).

Regarding claim 6, Stoneham discloses which has at least one optical element with the reflective function, wherein the amount of the light penetrated and the amount of the light reflected is substantially equal in the optical element with reflective function (mirror 5' and mirror 7', each has reflective function, figure 2).

Regarding claim 8, Stoneham discloses the lens and the transmittance variable element are arranged closely (lens 1' or lens 3', the mirror 7' and aperture plane defining plate 17' are arranged closely, figure 2).

Regarding claim 11, Stoneham discloses wherein the transmittance variable element has a transmittance distribution (column 2, line 43 – column 3, line 47).

Regarding claim 12, Stoneham discloses wherein the transmittance variable element does not have a portion which is mechanically movable when a photographing is carried out (the aperture plane defining plate 17' does not move, figure 2).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoneham (US 4,801,958) in view of Ise et al. (US 5,471,339).

Regarding claim 18, Stoneham fails to disclose wherein processing for resetting a transmittance control of the transmittance variable element which has been done for imaging to an initial state is carried out, after an imaging operation is completed. However, Ise et al. teaches the using of an electrochromic diaphragm 10 in an image pickup lens system 20 (figures 1, 3) for controlling the volume of light transmission of the light incident on CCD sensor 26. The light transmitting properties are changed by applying an electrical voltage onto electrochromic element which corresponds to reset a transmittance control to an initial state (column 1, lines 13-35; column 3, lines 30-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Stoneham by

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the teaching of Ise et al. in order to control volume of light transmission for the entire range of the visible light (column 1, lines 33-35).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID L. OMETZ can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LN
8/17/07



**LUONG T. NGUYEN
PATENT EXAMINER**